

Notice of Allowability	Application No.	Applicant(s)	
	09/671,674	KOMMA ET AL.	
	Examiner	Art Unit	
	John Juba, Jr.	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment under §1.116 filed July 7, 2004.
2. ☒ The allowed claim(s) is/are 1-85, 88, 92, 93, 113, 115, 122, 123, 126, 128 and 131-159.
3. ☒ The drawings filed on 12 November 2003 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/192,520.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>04/08/2004</u> | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

Reasons for Allowance

The examiner's reasons for the allowance of claims 1 – 85 stand as set forth in the Office action of May 12, 2003 for independent claims 1, 25, and 44. Claims 88, 92, 93, 113, 115, 122, 123, 126, 128, and 131-159 are allowable over the prior art for the reasons discussed by the examiner on Pages 12 – 14 of the February 11, 2004 Office action with regard to limitations recited in independent claims 133, 154 and 157.

Applicants' Supplemental Reissue Declaration filed July 7, 2004 is sufficient in overcoming the rejection of Claims 1 - 85, 88, 92, 93, 113, 115, 122, 123, 126, 128, and 131 –159 under 35 U.S.C. § 251 *as being based upon a defective reissue declaration*.

Applicants' amendment of claims 133, 154, and 157 to include to specific limitations discussed in their remarks, is sufficient in overcoming the rejection of claims 133, 154, 157, and claims 88, 92, 93, 113, 115, 122, 123, 126, 128, 131, 132, 134 - 153, 155, 156, 158, and 159 variously depending therefrom under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Remarks

Applicants' remarks concerning the alleged impropriety of the examiner's holding of impermissible recapture have been fully considered, but are not found persuasive. Applicants characterize the examiner's finding as attempting to dismiss the holding in *Ex Parte Eggert*, Appeal No. 2001-0790 (BPAI, May 29, 2003) and as relying instead on *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597, (Fed. Cir. 2001) and *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161, (Fed. Cir. 1997). The examiner does believe *Pannu* to be the binding precedent, but also believes that a finding of impermissible recapture is *not* inconsistent with either the *Eggert* decision or *Clement*.

The examiner agrees with Applicants (Pg. 17, third para.) that in light of *Eggert*, "a proper consideration as to the 'surrendered' subject matter would state that 'Applicants surrendered at most these broader aspects' since it is the unamended recitation, rather than the amendatory language (or argued features) which are surrendered." In the paragraph at the bottom of Page 16 of their remarks, Applicants correctly take issue with the examiner's expression of the surrendered subject matter. Indeed, it is not the five elements listed in the final rejection (bridging pages 5-6) which are surrendered, but rather, the subject matter of the canceled claims which did not contain these limitations. However, despite the examiner's imprecise expression of the subject matter surrendered, there can be little doubt as to the surrender of the broader scope.

Using the concentric circles diagram (Drawing 1) explained in *Eggert*, the region outside the circle ABC corresponds to the scope of the unamended claim, the region

Art Unit: 2872

within the larger circle represents the scope of the amended claim as argued for patentability, and the region within the smaller circle ABCDEF represents an issued claim believed to be unduly limited by the additional limitations DEF not specifically argued or related to the rejection. The region outside the larger circle is the surrendered subject matter. The region between the circles is not surrendered, and represents a scope of claim coverage which may be the subject of broadening reissue: "it is our view that the reissue recapture rule is not invoked for claims directed to elements ABCX, ABCD_{BR}, ABCEF, A_{BR}BCDEF". In the instant case however, a *succession* of narrowing amendments and arguments were entered. By analogy, the scope of the claims was diminished as a plurality of concentric circles. The subject matter between the circles was subject to administrative examination. It is believed that Applicants have not demonstrated the reissue claims to be of scope corresponding to the unexamined region between the issued claims and the canceled claims, in the context of *Eggert*.

Relying in part on *Clement*, *Eggert* advises:

- (1) if the reissue claim is as broad as or broader than the canceled or amended claim [the surrendered subject matter] in all aspects, the recapture rule bars the claim;
- (2) if it is narrower [than the surrendered subject matter] in all aspects, the recapture rule does not apply, but other rejections are possible;
- (3) if the reissue claim is broader [than the surrendered subject matter] in some aspects, but narrower [than the surrendered subject matter] in others, then:

(a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; or

(b) if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

The pattern in *Eggert* is the case where the broadening aspect (omitted limitations, DEF) *was not* related to the rejection, and where the narrowing aspect *was* related to the rejection. The present case is somewhat different. In the instant case, the reissue claim is broader [than the surrendered subject matter] in some aspects, but narrower [than the surrendered subject matter] in others (case (3)). Applicants urge that since the reissue claims are broader in an aspect germane to a prior art rejection, but narrower in an aspect *which is not* “completely unrelated to the rejection”, the claims do not fall within case (3)(a), and so the recapture rule must not bar the claim. However, considering case (3)(b) the examiner believes that, since the reissue claims are narrower in an aspect germane to a prior art rejection, and broader in an aspect *which is not* “unrelated to the rejection” the recapture rule *does* bar the claims.

The manner in which *Eggert* applies to the present case is made clear in the panel’s discussion of the concentric circles diagram: “a reissue applicant cannot recapture a claim directed to elements ABC (outer circle) or a claim entirely outside the outer circle (e.g., AB, BC, ABC_{BR}, etc.)” [footnote regarding notation “C_{BR}” omitted]. The examiner has identified specific features added to the unamended (parent) claims and argued as distinguishing over the prior art. By omission of these limitations *in their*

Art Unit: 2872

entirety, the previously rejected reissue claims impermissibly seek to recapture a subset of the region outside the larger circle, namely, a subset of claim coverage lying outside the scope of the unamended (parent) application claims.

The examiner acknowledges that his earlier analysis relies in part on the *Pannu* decision. In terms of the concentric circles diagram, the examiner's understanding of *Pannu* would be that the Court would permit broadening reissue claims which were drawn to the region between an arguably unduly narrow center circle $A_{sp}B_{sp}C_{sp}$ (the "sp" subscript signifying a more specific recitation) and an outer circle ABC. That is, Applicant may surrender subject matter outside ABC, but overshoot the mark by reciting $A_{sp}B_{sp}C_{sp}$. In the text bridging Pages 5-6 of the final rejection, the examiner identified five aspects in which the reissue claims are regarded as broadened in a manner approaching the canceled claims. The reissue claims are narrower than the canceled claims *in some aspects*, but are "not narrowed in any material respect compared with their broadening". This situation is impermissible under *Pannu*.

Applicants urge that under *Clement* the relation of the new (reissue) claim limitation must be to the previous *rejection*, not to the previously surrendered, or previously added, subject matter. From *Clement*, they conclude (atop Pg. 15) that "if the narrowed addition is related to 'the rejection' (i.e., to a prior art rejection), the claim does not seek recapture". However, this is not the conclusion drawn in *Clement*:

"In our case, reissue claim 49 is both broader and narrower in areas relevant to the prior art rejections. . . . On balance, reissue claim 49 is broader than it is narrower in *a manner directly pertinent to the subject*

matter that Clement surrendered throughout the prosecution. Even with the additional limitations, claims 50 – 52 are also broader than they are narrower *in a manner directly pertinent to the subject matter than Clement surrendered during prosecution.* (“Discussion” at [4], emphasis added).

“We agree with the board’s conclusion that the reissue claims are broader than the patent claims *in a manner directly pertinent to the subject matter that Clement surrendered* during prosecution. Therefore, it correctly applied the recapture rule” (last lines of “Discussion” at [5], emphasis added).

Despite Applicants’ urging to the contrary, it would be consistent with *Clement* to conclude that the claims can indeed be narrowed with an addition “related to the rejection” and nonetheless impermissibly seek to recapture surrendered subject matter.

Thus, while conceding certain inaccuracies in the examiner’s *expression* of the grounds of rejection, the examiner persists that the finding of *impermissible* recapture is supported by facts in the case and the relevant precedent.

Errata

Despite the possible ambiguity of the paragraph atop Page 9 of the action, Applicants have responded to each point raised in the final rejection of February 11, 2004. The paragraph is repeated below with markings to show what was intended to have been conveyed:

Insofar as the Reissue Declaration sets forth at least one error correctable under the statute, the examiner’s previous holding of the Reissue Declaration as being defective in this respect *is withdrawn*. Accordingly, the previous rejection of claims 1 - 85, 88, 92, 93, 113, 115, 122, 123, 126, 128, and 131 - 159 under 35 U.S.C. § 251 *as being based upon a [defective]*


Art Unit: 2872

Reissue Declaration defective for lack of correctable error is withdrawn. However, as set forth hereinabove, the declaration is now regarded as defective for not addressing every error corrected during the present prosecution.

Post-allowance papers should be mailed to **Box Issue Fee**. Post-allowance papers may also be faxed to correspondence branch in PUBs. The fax number is (703) 308-5083. The **PUBs customer service** number is (703) 305-8497.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Juba whose telephone number is (571) 272-2314. The examiner can normally be reached on Mon.-Fri. 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Drew Dunn whose number is (571) 272-2312 and who can be reached on Mon.- Thu., 9 – 5.


JOHN JUBA, JR.
PRIMARY EXAMINER
Art Unit 2872

July 13, 2004